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# SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1920.

No. [redacted]51

HERBERT L. HILDRETH, PETITIONER,

*v.*

JIM M. MASTORAS, RESPONDENT.

## BRIEF ON BEHALF OF RESPONDENT.

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# SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1920.

## No. 333

HERBERT L. HILDRETH, PETITIONER,

*v.*

JIM M. MASTORAS, RESPONDENT.

**BRIEF ON BEHALF OF RESPONDENT.**

### STATEMENT OF THE CASE

The above named petitioner presented to this Court his petition, No. 921, October Term, 1919, for certiorari to the Circuit Court of Appeals for the Ninth Circuit, and the petition, going over to the next term of the Court, was granted. The writ was issued, October 15th, 1920 (Record, p. 346) and by return made by the Court below, under date October 28th, 1920 (Record, p. 347), transcript was filed of record in this Court November 12, 1920 (Record, p. 348). Thereupon, the cause now comes before this Court for review.

The grounds set up in the petition aforesaid are, that the Circuit Court of Appeals for the Ninth Circuit in a certain cause therein pending wherein Respondent, Jim M. Mastoras is Appellant,

and Petitioner, Herbert L. Hildreth is appellee, said cause being numbered 3341 on the docket of said Circuit Court of Appeals, passed in said cause on the 24th day of February, 1920 (Record, p. 342) a decree, which said petitioner alleges to be erroneous and in opposition to the final decree of the Circuit Court of Appeals for the Fourth Circuit made in the cause wherein The Lauer and Suter Company were appellants and Herbert L. Hildreth, aforesaid, was appellee, said cause being numbered 1257 on the docket of said Circuit Court of Appeals, 219, Fed. Rep. 753, and reproduced in the record herein, pages 184 to 188.

Said petition (p. 31) also alleges as a ground of complaint:

> "The declaration . . . made by the Circuit Court of Appeals for the Ninth Circuit, viz., that to be validly patentable the device shown must be 'susceptible of use commercially,' constitutes an enlargement of or the engrafting of a new element upon the rule respecting operativeness formulated by this Court."

## INTRODUCTION

The Judgment or Decree of the Circuit Court in aforesaid case No. 3341, reversed (Record, p. 342) the decree (Record, pp. 30-31) of the District Court of the United States for the District of Oregon, No. 7466 of the docket of that Court, in

which Herbert L. Hildreth, aforesaid, was complainant, and Jim M. Mastoras, aforesaid, was defendant.

The cause in said District Court was a suit in equity brought by the said Herbert L. Hildreth who filed his bill (Record, pp. 3-6) in usual form alleging his ownership of U. S. letters patent No. 831,501, issued September 18, 1906, upon application made by Herbert M. Dickinson for alleged new and useful improvements in Candy-Pulling Machines, said patent being hereinafter denominated the Dickinson patent (See Record, pp. 222-225) and alleging infringement of claim 1 of said patent. Defendant in his answer (Record, pp. 8-13) denying all material allegations of the bill, specifically denies the validity of the Dickinson patent and his infringement thereof, though he admits the making of but one machine made in accordance with the specifications of U. S. letters patent No. 1,232,697, issued to him, the defendant, July 10, 1917, upon the application of the inventor G. L. Langer, for Improvements in Candy-Pulling Machines, and hereinafter denominated the Langer patent (Record, pp. 297-301).

The decision of the said District Court (Wolverton, Dist. J.) sustained the validity of claim 1 of the Dickinson patent, allowed injunction against defendant, and, pending an accounting, issued accordingly an interlocutory decree (Record, pp. 30-31).

Thereupon, defendant appealed to the Circuit

Court of Appeals for the Ninth Circuit, as aforesaid, setting up ten Assignments of Error (Record, pp. 34-35) which at the argument of the case were narrowed, in effect, to denial of infringement of the Dickinson patent, and denial of validity of the same (See Record, p. 333).

The said Circuit Court of Appeals reversed the decree of the District Court as aforesaid. Pending the issue of the mandate of said Court, the petitioner herein presented his petition for certiorari to this Court, and afterwards the petition was granted as aforesaid.

The Circuit Court of Appeals for the Fourth Circuit in aforesaid case No. 1257 (Record, pp. 184-188) affirmed the decision, with approval of its reasoning, and the decree of the District Court of the United States for the District of Maryland, in the case therein in which Herbert L. Hildreth, aforesaid, was complainant, and Lauer and Suter Company were defendants, 208 Fed. Rep. 1005 (Reproduced in Record, pp. 167-182) and in which the Court sustained the validity of claim 1 of the Dickinson patent.

The opinion of the District Court in the case last named (Rose, Dist. J.) shows that suit was brought by complainant, Hildreth, the petitioner herein, on a bill in equity charging infringement of a Jenner patent No. 804,726 (to which further reference in the case now before this Court is unnecessary) and claims 1 and 2 of the Dickinson patent—the patent involved in the case at bar.

The statement of the facts in the case made by Judge Rose is confirmatory of the independent proofs made in the present case (See Record, *re* Interference No. 21523, pp. 206-207, 210, 211, and pp. 125-153, 154-156, 157-162, 163-166) to the effect, as set forth in his opinion (Record, pp. 167-182, *supra*) that claim 1 of the Dickinson patent was finally awarded to Dickinson on judgment of priority in an interference which extended over several years, and was terminated by decision of the Circuit Court of Appeals of the District of Columbia on Appeal taken in said Interference.

It appears also (Record, p. 169) from Judge Rose's opinion, aforesaid, which opinion is *in evidence* in this case, that the said Interference involved six parties, all of whom obtained separate patents. Four of those six parties either personally or in respect to the patents respectively obtained by them as the outcome of said interference, were concerned in the aforesaid suit before the District Court for Maryland. Hildreth, who was himself a party to that Interference, brought the suit, under allegation of ownership by purchase of both the Dickinson and Jenner patents, against the defendants who purchased from one Henry who was originally included in said Interference, and was the first to emerge from it with a patent.

The controlling facts in the Maryland suit, consequently, are that the suit was brought in the right of a successful party to an Interference in the Patent Office, against a customer of a defeated

party to the same Interference who had narrowed the claims of his patent in order to get it at all, and who had subsequently, under threat of suit, assigned all his rights in the patent he got to the complainant Hildreth, with the sole exception of one machine that was made by the Henry aforesaid and sold to defendants in the suit in the Maryland District Court before he, Henry, had surrendered to Hildreth. The defense in that case was, therefore, limited to such defense as Henry might have made and no other. Henry had had an opportunity to contest the interference in which Dickinson won out, but he refused to make the contest, restricted his claims accordingly, and was bound—he and his privies, including defendants in the Maryland case—by his refusal.

It was upon a full showing of all the facts as last hereinbefore set forth that Judge Rose rendered his decision in the Maryland case, and that the Circuit Court of Appeals for the Fourth Circuit, in the aforesaid case, No. 1257, in said Court, very properly affirmed that decision.

In the case at bar, Respondent's title is clouded by no previous relationship subsisting between him, or between any one from whom he derives title, and Petitioner. Respondent's machine is a new machine, novel in principle, and covered by letters patent of the United States. What is, also particularly worthy of note is that the Petitioner Hildreth himself, admits that he has no patent on the specific construction embodied in Respond

ent's machine (See Record, bottom of page 93 and top of page 94).

The record in the case at bar abundantly shows, it is submitted, that nearly twenty years ago a group of inventors did independently under various forms invent a certain type of machine for pulling candy.

The U. S. Patent Office held that that was not the first candy-pulling machine, it having granted as early as December 19, 1893, a machine for working or pulling candy, to wit, Patent 511,011, issued to P. J. G. Firchau (Defendant's Exhibit K, Record, p. 267 *et seq.*). Upon that patent one claim made by Dickinson in his application for patent was rejected by the Patent Office (Record, p. 213, last paragraph) and was accordingly cancelled by Dickinson (Record, p. 214).

Every patent upon different varieties of the type of machine, aforesaid, was acquired by the Petitioner, by purchase or otherwise, and any inquiry, which could not be made in an Interference proceeding, but which might otherwise have been raised by a competitor inventor under the provisions of section 4915, U. S. Revised Statutes, was stifled by such purchase. He was, perhaps, entitled to the rich monopoly he has enjoyed undisturbed through many years. But lapse of time has brought about, in the present instance, that very progress in the useful arts which the patent laws are designed to promote. In this inventive age of ours, twenty years is a long period for the

hands of the clock of progress to stand still, yet it is now nearly twenty years since the application for the Dickinson patent was filed, and it was fifteen years after Dickinson entered it that Langer entered the field.

The petitioner herein is asking this Court to extend by construction a mere paper patent, a patent drawn to a machine that is not shown ever to have been made or used, in order that he may make tributary to that patent a new type of machine, totally different, in appearance and, as Respondent contends, in principle, from any machine that preceded it. To establish such a claim, actual proof is demanded and not the bare assertions of self interest and expert speculations which alone are offered on behalf of the Petitioner.

## BRIEF OF ARGUMENT

### I.

There is no conflict between the decision rendered by the Circuit Court of Appeals for the Ninth Circuit in the case of Jim M. Mastoras v. Herbert L. Hildreth, numbered 3341 on the docket of said Circuit Court of Appeals (See Record, pp. 332-342) as certified in return (Record, p. 347) to Writ of Certiorari issued by this Court, October term 1920, No. 333 (Record, p. 346) and the decision rendered by the Circuit Court of Appeals for the Fourth Circuit in the case of The Lauer & Suter Company v. Herbert L. Hildreth, numbered 1257 on the docket of said Circuit Court of

Appeals, 219 Fed. R. 753 (See Record, pp. 184-188) said decisions being those two set up in support of petition for Certiorari presented to this Court, October Term, 1920, No. 333.

This proposition is demonstrated by the following considerations:

(a) In the case first above named, while the opinion of the Court rendered therein does indeed give serious and just grounds for doubt of the operativeness and utility of the Dickinson machine, the decision, nevertheless, is based, not upon adjudicated invalidity of the Dickinson patent, but stands squarely and independently upon the single proposition that the appellee in that case, the Petitioner in this Court, failed to sustain the charge of infringement.

(b) The decision in the case last above referred to, is predicated upon a narrow state of facts which restricts the scope of that decision to a case totally different, in every particular, from that submitted to and decided by the Circuit Court of Appeals for the Ninth Circuit; and it goes so far as to hold, only that upon such restricted state of facts as is set up, the Dickinson patent must be held valid and infringed.

Viewed, therefore, in the light of the state of facts presented before those respective courts, and as hereinafter in the argument fully set forth, it is clear, not only that the two decisions aforesaid do not conflict, but also that no broad

scope can be ascribed to the opinion of the Circuit Court of Appeals for the Fourth Circuit except only upon a misconstruction growing out of a misapprehension of the matter in issue before that Court. The issue in that case and the decision thereon necessarily restrict the meaning of any language employed by the Court in its opinion to narrow limits, as imposed by the precise state of facts presented by the case submitted to it for decision; and if beyond those bounds the authority of the decision would not, even within the jurisdiction of the Court, be held to extend, there is no theory upon which it is possible to maintain that an independent tribunal has erred because it has reached an independent decision in a different case involving a contradistinguished state of facts.

II.

The Dickinson patent in suit, No. 831,501, is invalid, because it does not describe the invention therein alleged to be set forth, in "full, clear, concise, and exact terms," as the statute requires.

III.

A decision, to validate the Dickinson patent if the patent should be held to comply with the statute, need not hold that Respondent's machine infringes that patent.

IV.

Claim 1 of the said Dickinson patent is invalid, because, in respect to that claim, the patentee fails to comply with the statute, in that he does not "particularly point out and distinctly claim, the part, improvement, or combination which he claims as his invention or discovery."

V.

Respondent does not infringe the said Dickinson patent sued upon for the following several reasons, to wit:

(a) There is no identity between the subject matter shown and described in said patent, and Respondent's machine.

(b) A difference in principle exists between the machine shown and described in said patent and Respondent's machine.

(c) The only evidence offered to establish the infringement charged against Respondent is incompetent.

(d) In respect to claim 1 of said patent—the only claim involved in this suit—the subject matter of that claim is, by its very terms, differentiated from Respondent's machine.

VI.

A broad view of the matter in controversy leads to the conclusion that it is possible for this Court to determine, as between the parties, the whole

question involved, and the interests of justice invoke the exercise of its power to dispose of the cause in such terms as to put an end to litigation between the parties.

## ARGUMENT.

### I.

### No Conflict Between Decisions of the Several U. S. Circuit Courts of Appeal.

#### (a) decision by u. s. circuit court of appeals for the ninth circuit.

The opinion upon which decision was rendered by the U. S. Circuit Court of Appeals for the Ninth Circuit, in case No. 3341, of that Court, Jim M. Mastoras, Appellant, the Respondent here, v. Herbert L. Hildreth, Appellee, the Petitioner here, is printed in the Record, pages 332 to 342, inclusive.

We desire to express our entire accord with the reasoning and conclusions reached by the Court in said opinion, and, in order to save needless repetition we adopt said pages 332 to 342, inclusive, of the Record, to all intents and purposes as if they were reprinted in this brief.

The opinion rendered in said case (Honorable William B. Gilbert, Circuit Judge) shows that "Appellant appeals from a decree of the Court below (U. S. District Court for Oregon) whereby he was adjudged to have infringed claim 1 of Patent No. 831,501, issued on September 18, 1906

to Herbert M. Dickinson for an 'Improvement in Candy-Pulling Machines.' The appellant denied infringement and denied the validity of the Dickinson patent."

The opinion (Record, p. 333) next refers to the prior art found in U. S. patent No. 511,011, issued to Firchau on December 19, 1893, for an improvement in "Machines for Working or Pulling Candy" (Record, pp. 267-270 and page 266, the attention of the court being invited to errors in printed record, to wit, the misdescription of Defendant's Exhibit K, page III of Index, and the misplacing in the Record of pages 266 and 271). Next, the opinion (Record, pp. 333-4) proceeds to analyze portions of the Dickinson patent upon which suit is brought (See Record, pp. 222-225) and to analyze (Record, pp. 334-5) Respondent's patent No. 1,232,697, issued July 10, 1917, upon application of G. L. Langer (See Record, pp. 295-301), describing the several operations of the machines of the two patents last named.

Comparing the Dickinson and the Firchau patents, the opinion (Record, pp. 335-6) states:

> "It is said that the Firchau patent has no place in the prior art for the reason that it will not pull candy, but will only mix it. To this we cannot assent. The moving fingers of that device undoubtedly will to some extent pull candy. The candy being placed upon

the upper finger which has projecting knobs to hold it, will as that finger moves be caught by the lower finger and pulled in the opposite direction. If it be said that the pulling operation is not continuous but intermittent, the same may be said of the Dickinson device for it is obvious that during the travel of the movable pins from the end of the trough toward and to the central pin there is no pulling of the candy or anything more than a pushing of the mass thereof in front of the moving pins. It is only as Dickinson's moving pins travel away from the center and toward the ends of the trough that any tension is placed on the candy. It is thus seen that Dickinson did not get very far beyond Firchau and that in his device as in Firchau's, the candy is 'alternately massed and stretched.' Although claim 1 of the Dickinson patent does not call for means to support the candy against gravity, it is obvious that the device will not operate without a trough for support, such as the specifications describe, and that if the pins were placed in a horizontal position they could not be so operated as to sustain the candy against gravity, for the reason of the intermittent relaxation of the candy from all tension. In Hildreth v. Auerbach, 223 Fed. 545, Judge Learned Hand said: 'I must confess that the conception of the pins as "supports"

seems to me quite foreign to Dickinson's disclosure.' Dickinson was not the first to invent a machine to pull candy. But if he were the first, as the appellee contends, he acquired no more than the exclusive right to pull candy in the way which he specified, and he is not justified in claiming the exclusive right to pull it in some different way."

(The language contained in the last preceding paragraph is quoted in full because it fully and clearly, but concisely, sets forth the true relationships severally subsisting between the Firchau patent, which is the true pioneer in the art, and the successive patents of the Petitioner and of the Respondent.)

Following the analyses, comparison of patents, and conclusion last above noted, the Court proceeds: "The testimony leaves it doubtful whether the Dickinson machine is operative" (Record, p. 336). It bases that conclusion upon the only testimony introduced as to its practical operation, namely that of the party Hildreth.

The Court then quotes (Ib.) the admission of inoperativeness of the Dickinson machine as made by the said party Hildreth in the District Court, and his condemnation, in his own patent No. 832,384, of the principle of the Dickinson patent before his purchase of it (Record, p. 337). The Court also quotes the testimony of a witness for the appellant, an experienced candyworker (See

testimony of Henry Ross, Record, p. 119) to like purport.

Recognizing (Record, p. 337) the authority of the decision made by this Court in Bement v. National Harvester Co. 186 U. S. 70, 90, the Court of Appeals holds (Ib.) "But it is also true that if the patented device is not operative, it cannot be infringed by one that is." (Five cases cited headed by Royer v. Coupe, 29 Fed. 358). Conceding also (Record, p. 338): "A device need not be perfect in order to escape the charge of inoperativeness," Engineering Co. v. Hotel Astor (Judge Hough) 226 Fed. 779, 783, the Court of Appeals distinguishes the case last noted from the present one as a case in which the Court found the evidence to show "substantial performance." The opinion, (Record, p. 338) reads:

> "The case at bar is not one of those in which the first embodiment of a generic invention works imperfectly, but in which the defects may be remedied by readjustment or relative changes in size or shape or construction of members. It is not a case in which the invention as described is crude or defective, but is susceptible of improvement."

(Thus in forceful language the Court considers and rejects the contention of the appellee therein (Record, p. 336) that he had made a change in the Dickinson machine—a change whose nature

he only vaguely pretends to disclose—and rejects the bare assertion of the witness that, in so doing, he made it work.)

"If," continues the Court, "there is inoperativeness here, it is inherent in the very conception and structure of the device. If it is not susceptible of use commercially it has no utility, for it is obvious that such a machine can have no utility except in the commercial field."

It is to the language of the last sentence that counsel for Hildreth in his Petition to this Court (October Term, 1919, No. 921, page 4) takes specific exception (*ib.* p. 31) as follows:

> "The declaration thus made by the Circuit Court of Appeals for the Ninth Circuit, viz., that to be validly patentable the device shown must be 'susceptible of use commercially,' constitutes an enlargement of or the engrafting of a new element upon the rule respecting operativeness formulated by this Court."

It is because of the last allegation by counsel we quote the context of the opinion at length. The language of the Court referred to does not, it is submitted, go so far as to hold as a rule of law "that to be validly patentable the device must be susceptible of use commercially."

Opposing counsel arrive at an erroneous construction of the language used by the Court, when they confuse the language actually used by the

Court with the interpolated words: "that to be validly patentable the device must be," which the Court did not use. What the Court really did hold, and justly hold *(Supra,* p. 17) is:

> "If there is inoperativeness here, it is inherent in the very conception and structure of the device."

The proposition in the sentence last quoted is all-sufficient to support the Court's decision—if its decision had really rested upon a finding of inoperativeness; and the foregoing quotation immediately following relating to "use commercially," might still be only *obiter,* however sound, in respect to the Dickinson machine. The Court, however, is considering the nature of "the invention" itself, and not a specific embodiment of the invention.

But the decision of the Circuit Court of Appeals for the Ninth Circuit under consideration does not rest at all upon any finding of inoperativeness, or want of utility. Distinctly to the contrary, the Court, in its opinion (Record, beginning middle of page 338), says:

> "But aside from the question of the operativeness and utility of the Dickinson machine, we are of the opinion that the decree should be reversed for failure of the appellee to sustain the charge of infringement."

Thus, the Circuit Court of Appeals plainly de-

clares the only ground upon which it rests its decision—a ground that is wholly independent of any other consideration, and one that is sufficient to sustain the reversal of the decree of the trial Court.

Regarding the question of infringement as one of law and of fact, as it should do, the Court fortifies its opinion by reference to numerous cases (Record, p. 338) in support of the proposition: "It is a legal presumption that a later patent does not infringe an earlier patent." That presumption is recognized in the Ninth Circuit as established, and if it is not so regarded in all other circuits, the ruling of this Court upon that point of law would appear to be in order in the present case, and would effect the desirable result of unifying the practice throughout all the circuits.

The Circuit Court of Appeals also relies (Record, p. 339) upon the familiar rule, as established by this Court in Burr v. Duryee, 1 Wall. 531, and followed in subsequent cases, that a patent for a machine cannot cover a mode of operation, citing also Knapp v. Morss, 150 U. S. 221, 227, and quoting from language of Mr. Justice Brown in Westinghouse v. Boyden Power Brake Co., 170 U. S. 537, 556; but its decision, after a comprehensive and thorough analysis and comparison (Record, pp. 340 and 341) of the machine as described in the Dickinson patent, and of the Langer machine, rests squarely upon the following findings of fact, to wit:

"It is true that in both patents there is a common use of the term 'figure 8,' as descriptive of the operation of the respective devices. In the Langer patent the term is applicable, for the moving puller and the candy which it carries describe a true figure 8. In the Dickinson specification two moving pins in conjunction with a stationary pin 'move the candy' along a patch corresponding to 'what I term a figure 8.' It is impossible, however, to find in the operation of the Dickinson machine a movement of candy in the course of a figure 8. As the candy reaches the end of the trough, it stands in the shape of a letter V. When the movable pins are reversed, the sides of the V are brought together, and the ends are twisted about and then the candy is massed and pushed on the reverse movement back to the stationary pin which again divides it into the form of a letter V. Dickinson's in-and-out movement is shown by the accompanying plat. The movable pins travel in the trough past the fixed pin f, proceeding respectively on the lines a and b, to the end of the trough, the right-hand pin in advance of the left. When they reach the end of the trough, they are respectively at d and e. As they turn to the left on their common axis and start on their return travel, one pin describes the arc dc, and the other the arc ce, and they continue in their course past the

fixed pin f to the opposite end of the trough where the same turning movement is repeated.

In the Dickinson machine the pulling pins, yoked together, move with a reciprocating motion back and forth in a trough, with a reversing motion at each end of a trough, and they alternately push and pull a mass of candy lying in a trough. There is no lapping of candy, strand upon strand. In the Langer machine, a single pulling member moving in a continuous circular path, continuously exerts a pulling force on a mass of candy suspended in the air."

The familiar doctrine of the law relied upon by the Circuit Court of Appeals (Record, p. 341) is set forth by the Court in language we deem it unnecessary to quote here, but is to the effect that substantial identity between two machines, not mere identity of result, is necessary to sustain a charge of infringement, quoting the doctrine as laid down by this Court in Burr v. Duryee, 1 Wall. 531, 572 *(Supra)* and as confirmed by this Court, even in respect to a pioneer invention, in Westinghouse v. Boyden Power Brake Co., 170 U. S. 537, 569.

The decree of the District Court for the District of Oregon was reversed with costs in favor of appellant and against the appellee, and the cause

remanded to the said District Court with instructions to dismiss the bill (Record, p. 342).

Petition for rehearing having been considered and denied (Record, p. 343), the mandate was stayed by order of Court, April 9, 1920, and now awaits the action of this Court.

## I.

### (b) DECISION OF THE U. S. CIRCUIT COURT OF APPEALS FOR THE FOURTH CIRCUIT.

Although other decisions are referred to in argument, yet the only one regarded as relevant is that rendered by the Circuit Court of Appeals for the Fourth Circuit, and entitled in the records of that Court No. 1257, The Lau(t)er and Suter Company, Appellant, versus Herbert L. Hildreth, Appellee (Record pp. 184-188). That is the only decision of any U. S. Circuit Court of Appeals that is alleged to conflict with the aforesaid decision of the U. S. Circuit Court of Appeals for the Ninth Circuit.

The decision made by the Circuit Court of Appeals for the Fourth Circuit in the cause aforesaid, No. 1257 in that Court, is one rendered on appeal from the decree of the District Court for the United States for the District of Maryland (Rose, D. J.) in the case of Hildreth v. Lauer and Suter Company, 208 Fed. 1005 (reproduced in record, pp. 167-182).

The two cases last referred to are in effect one,

and both involve two patents, to wit, aforesaid patent to Dickinson No. 831,501 (Claims 1 and 2), and patent No. 804,726, issued November 14, 1905, to Edward J. Jenner. It is in respect only to so much of its decision as holds that claim 1 of the said patent No. 831,501 is valid, that the decision of the Circuit Court of Appeals for the Fourth Circuit has any bearing upon the case at bar.

Claim 1 of the Dickinson patent is the sole claim alleged in the case at bar to be infringed. With that portion of the decision by the Circuit Court of Appeals for the Fourth Circuit or of the District Court affirmed thereby, which affects, at least directly, the said patent No. 804,726, the cause at bar is not concerned. An indirect bearing upon the case at bar in respect even to the patent last named will be indicated in a subsequent part of this brief. Accordingly, directing attention at this time to so much of said decision as is pertinent, it appears from the opinion of the District Court (Record, pp. 167-182) that the suit was brought by Herbert L. Hildreth, owner by assignment of both patents, as plaintiff, who charges conjoint infringement of two claims (1 and 2) of the Dickinson patent No. 831,501, and claims of the Jenner patent aforesaid.

It further appears from the opinion of the District Court (Record, p. 169) that the said Dickinson was the successful contestant, to whom award of priority was made, in an Interference proceeding instituted in the U. S. Patent Office. To that

Interference there were, according to the finding of the said Court, originally six parties, including Dickinson and Jenner, aforesaid, and also an inventor named Henry.

The Interference was contested between the plaintiff (Hildreth), as assignee of Jenner, and Dickinson, to a final decision by the Circuit Court of Appeals of the District of Columbia. When award of priority to Dickinson was confirmed by that Court on appeal, Hildreth purchased the said Dickinson patent. Being himself one and a defeated party to the aforesaid Interference, Hildreth became in his own right and by purchase the owner of all the patents originally involved in it (Compare pages 169 and 171, first par. of Record) save and except that of the party Henry above named (Record, p. 172).

The patent to Henry was the first one to issue upon any of the applications involved in the Interference, aforesaid. It was issued June 23, 1903, and is No. 731,681 (Record, p. 169).

In the case under consideration decided by the U. S. District Court of Maryland, it was said:

> "The alleged infringing device is constructed in accordance with the disclosure of the Henry patent. That patent was the last of the six to be applied for. When an interference was declared between its original claims, or some of them, and those of the other applicants, Henry canceled such of his

claims as were said to conflict with those found in other pending applications." (Record, p. 172.)

Henry limited his claims to his precise species in order to obtain his patent (Record, p. 172).

"Henry, by declining to go into interference, obtained his patent with its limitations years before those of Dickinson, Hildreth or Jenner emerged from the office. His assignees at once went into the business of making and selling machines. Quite a large number were in use in various parts of the country before Hildreth was in a position to begin any legal proceedings. When he finally obtained his patents he began, or threatened to begin, suits against both makers and the users of the Henry machines. The then owners of the Henry patent thereupon agreed to assign it to Hildreth. He paid them some thousands of dollars for it. Stipulation was made that he would release all of his claims against those who had used machines sold by his assignees, provided, however, that such users surrendered the machines they had to him. Such surrenders were to be made upon terms which from his standpoint and upon the assumption that the broad claims of his patents were valid, were fair enough. The defendant, however, refused to accept them or to cease

using a Henry machine of which it had become the owner." (Record, p. 173.)

Thus, by his own act, Henry conceded invention and priority of invention to Dickinson, who contested, *inter alios*, the interference, to a successful termination.

Henry's assignees agreed to assign and did assign the Henry patent to Herbert L. Hildreth who paid them some thousands of dollars for it upon stipulation that he would release all his claims against users of machines purchased from said assignees "provided, however, that such users surrendered the machines they had to him" (Ib.).

The said defendant (Lauer and Suter Company), however, refused to accept the terms of settlement under the sale of the Henry patent or to cease using "a Henry machine" of which it had become the owner.

As owner of that one machine the title of the said defendant was only what Henry's assignees could give. It therefore follows, that the case before his Honor, Judge Rose, of the District of Maryland, was one restricted to the precise state of facts as above set forth, and that the power of the Court was exhausted by its decision, that, upon that state of facts and that state of facts only, the Dickinson patent must be held valid and infringed. No case independently of the relationship of the parties as affecting claim 1 or any other claim of the Dickinson patent was presented to the Court for its decision. The same

observation applies in respect to the defense of "inoperativeness," as it was attempted to be raised in said case.

The same state of facts as in the lower Court was before the Circuit Court of Appeals for the Fourth Circuit on the appeal, and the appellate Court could, therefore, not do otherwise than to decide as it did, in the words of Judge Woods, speaking for the Court, as follows:

> "The reasoning of the District Judge by which he reaches *the conclusion that the defendant's candy-pulling machine operating under the Henry patent* (italics ours) is an infringement of the prior right of the complainant Hildreth as assignee under the first claim of the Dickinson patent, leaves nothing to be added." (See Record, p. 185.)

Citations in the record and opponent's brief, to other cases than the one last noted are, it is submitted, not in point. But every decision thereto rendered by any court in respect to the matter in suit, except the case at bar, is affected by limitations, such, for example, as those which controlled the decision aforesaid of the Circuit Court of Appeals for the Fourth Circuit.

That case, it is submitted, does not, for reasons above set forth, conflict with the decision of the Circuit Court of Appeals for the Ninth Circuit rendered in the case at bar, and presents no such scope as that attributed to it by Petitioner.

## II.

THE DICKINSON PATENT IN SUIT, No. 831,501, IS INVALID BECAUSE IT DOES NOT DESCRIBE THE INVENTION, THEREIN ALLEGED TO BE SET FORTH, IN FULL, CLEAR, CONCISE AND EXACT TERMS, AS THE STATUTES REQUIRES.

Under the present head, the attention of this Court is invited to the following items that are deemed to be material:

The said Dickinson patent (See Record, pp. 222-225) purports to show and describe "Improvements in Candy-Pulling Machines" (Dickinson, Spec. p. 1, lines 6-7, Record, p. 223). It describes a trough B, having in its bottom an upright "stationary pin" G. Pins F and F', that are oppositely disposed to the pin G, are carried by a plate E', that is assumed to travel back and forth lengthwise of the trough B under actuation of a screw-shaft H, which is in operative communication with the plate E' through the medium of a screw-threaded nut C and a connecting frame T, that is, at best, specified but loosely. Reversal of rotative motion of the shaft H, at definite intervals, is necessary to secure continued operation of the machine, even so far as to produce intermittent movement of the plate E' in opposite directions relatively to the longitudinal axis of the shaft H.

The defect in the specification and drawing alleged in this connection is, that while "shifting

devices" S and K for shifting the bands (belts) R and R', respectively, so as to give reverse motion to the screw-shaft H, are specified (Ib. lines 78-79), no operative mechanism is shown for connecting the members S and K with the nut C or any other member whereby the alleged operation of the members S and K may be accomplished.

This omission is important in itself, but is rendered the more important by reason of its relationship to further defects of the patent drawing and specification as next hereinafter indicated.

The specification (Ib. lines 55-57) describes D and D' as "stops," one at each end of the candy-receptacle, and adapted to change the position of the pins F and F'—"when brought in contact with the said stops, as hereinafter described."

It is obvious that the pins F and F' never come "in contact with said stops." The said stops may, possibly, come alternately in contact with an arm E "on the plate E' which supports the pins F and F'" (Ib. lines 60-61).

The nature of the connection between the elements E and E' is left wholly to conjecture, and the plate E has a marked peculiarity of shape in respect to which neither object nor function is so much as hinted at in the specification.

In the description of the operation (Ib. lines 86 to 104 inclusive) it is stated, positively, "the screw-shaft H is turned in proper direction to convey the frame T to the right, as shown in

the drawings, until the arm E comes in contact with the stationary stop $D^1$, thereby shifting the positions of the pins or hooks F and $F^1$ in the candy" (Ib. lines 87-93). A similar operation in respect to "the stationary trip D" is specified (Ib. lines 96 to 100).

Now, it is perfectly obvious that contact only, between the arm E, and the members D or $D^1$, described in the body of the specification as "stops," one only being mentioned in line 98 as "the stationary trip D," will effect no shifting of position of the pins F and $F^1$ as specified. Such contact, indeed, and especially with a *stationary* element, will effect no other operation upon the arm E than simply a "stop," which the terms of the specification call for—that and nothing more. But a stop will afford an interruption and not a continuance of the operation of the machine.

It is not for counsel, or for any one else, to offer any *conjecture* as to what the inventor might have intended to specify. The specification is finished and is open only to construction. Conjecture has no place in a patent specification. It is to substitute certainty for uncertainty, like conjecture, that the language of the statute (R. S. 4888) was chosen with scrupulous exactitude, to define just what a patent specification shall contain.

It would appear sufficiently serious, in and of itself, that material defects, as pointed out above

should exist in the patent; but their importance is augmented by the fact that what was asserted only to be "a model," has been offered and *was considered in evidence* by the trial court, as "showing the mechanical operation of the (plaintiff's) machine, and it is within itself a demonstration that it pulls candy" (Record, p. 22, end of first par.). Reduction to practice is not shown by a model in any case. *Robinson on Patents,* Vol. I, Sec. 126.

Inspection of the alleged "model" will, upon comparison of the "model" with the specification of the Dickinson patent, disclose that there is no showing made in that specification from which it would be possible to build such a "model" or indeed any mechanically operative model or machine. The "model" is a bold assumption that the defects which we have pointed out in the specification do not exist, whereas, it is, in respect to those very defects, insisted that the patent fails to comply with the statute, and, is, therefore, invalid.

III.

There is no necessity to apply the familiar rule, *"ut res magis valeat quam pereat"* in order to validate the Dickinson patent. The allegations of invalidity urged against it in whole or in part under headings II and IV, respectively, of this brief, are urged upon strictly statutory grounds.

If this Court should hold that the necessary requirements of the patent act have been complied with, it is by no means necessary, in order to validate the patent, to hold that it dominates Respondent's machine.

On the contrary, claim 1 of the Dickinson patent calls for no more than "means for producing a specified in-and-out motion of those parts," whatever "those parts" may designate. As is well brought out in the opinion of the Circuit Court of Appeals in this case (Record, p. 334) in reference to the Dickinson patent, the specification of that patent (Dickinson patent, page 2, lines 19-22, Record, p. 224) says: "In either case (regarding the relationship of motion between the pins or hooks) the candy is acted upon in a manner and by means of the shifting hook along a path corresponding to what I term a figure '8'."

What Dickinson meant by the words "what I term a figure 8," is unintelligible since, as the Circuit Court of Appeals says: "It is impossible, however, to find in the operation of the Dickinson machine a movement of candy in the course of a figure 8."

The language of the Dickinson patent, meaningless though it is, is appealed to on behalf of Petitioner to establish a resemblance between the Dickinson patent and Respondent's machine described in the Langer patent, because in the Langer patent the "floating puller or carrier 12" does actually travel in a path corresponding to the

figure 8. Even in respect to the machine of the Langer patent, the language is not strictly accurate, because the movement of the carrier 12 is, for a definite purpose, directed along the lines of a figure 8, only if that figure be conceived to be laid on its side. Even then motion must be in one direction only, and not in either direction as will be hereinafter explained under caption V (b).

Again, there is no hint in the Dickinson patent itself that omission of the trough B of that patent was contemplated. Some means of support for the candy must be understood, and despite the fact that claim 1 does not call for it, the trough B is the only means to "support the batch of candy to be operated upon" (See Dickinson patent, page 1, lines 49-50, Record, p. 223) and the trough B is repeatedly indicated for the same purpose, elsewhere throughout the Dickinson specification.

The necessity for the trough B is observed not only in the opinion of the Circuit Court of Appeals in the case at bar (Record, p. 346), sentence beginning line 2) but also by Judge Learned Hand in Hildreth v. Auerbach, 223 Fed. Rep. 547, quoted in said opinion (Record, *ib.*, lines 11-13).

The "specified in-and-out motion" named in claim 1 of the Dickinson patent appears to mean, so far as it means anything, a motion of

"the candy hooks within the receptacle which

holds the batch of candy, but any other suitable means may be used. I have also shown in the drawings, a trough for supporting the candy, but any suitable support may be used, which has the capacity for supporting the candy while it is being operated upon, as hereinbefore described" (See Record, p. 199).

Obviously, if Dickinson had contemplated the omission of the trough he would have mentioned it. If the possibility of such omission is inherent in the Dickinson invention even though he did not know it, it is susceptible of actual fact proof, which is the only proof that will satisfy the nature of the case.

*Fried, Krupp Aktien-Gesellschaft v. Midvale Steel Co.*, 191 Fed. Rep. 588-612 (p. 591).
*Natl. Mach. Corp. v. Benthall Mach. Co.*, 241 Fed. Rep. 72-89 (p. 86).

## IV.

CLAIM 1 OF THE DICKINSON PATENT IS INVALID, BECAUSE IT DOES NOT COMPLY WITH THE REQUIREMENTS OF THE STATUTE (REV. STAT., SEC. 4888).

Contrary to the statute, claim 1 is utterly indefinite, vague, and uncertain in that one of the essential elements it calls for, to-wit, "a candy-puller" is nowhere found in the descriptive portion of the specification. What the term "candy-

puller" means cannot be determined from the patent. Introduced into the body of the claim, as it is, it entirely confounds its meaning.

Upon analysis, it will appear that said claim 1 comprises in a candy-pulling machine the following elements, to wit:

(1) a plurality of oppositely-disposed candy hooks or supports,
(2) a candy-puller, and
(3) means for producing a specified relative in-and-out motion of those parts for the purpose set forth.

Judge Rose (Record, p. 170, lines 10, 12, and 30) repeatedly designates an entire machine as "a candy-puller." On the next page of the Record, line 11, referring to Dickinson, he says:

> "It was he who had found out that a combination of a candy-puller and a plurality of oppositely disposed candy-hooks or supports could be given a relative in and out motion which would carry candy along a figure 8 pathway and that candy could thereby be pulled."

Even granting, *arguendo,* that Dickinson had done the thing Judge Rose ascribes to him, the doing of it does not constitute a compliance with the statute. He might just as well have kept it a secret as to pretend to disclose his invention in

language that is unintelligible. The requirement of the statute appears for the moment to have escaped the learned Judge's attention, when he accepts without comment the term "candy-puller" of the claim.

Element (1), according to the foregoing analysis, includes, potentially at all events, the three members, F, F', and G, because F and F' specified in the Dickinson patent as "pins" (Record, p. 223, lines 62, 85 and 99, and in line 93, as "pins or hooks") are indiscriminately confused as "pins" and "hooks" on page 224 of the record with the member G, specified on page 223, line 65 thereof as "the stationary pin." Moreover the pins or hooks F and F' are oppositely-disposed to the pin or hook G, because G extends upwardly from the bottom of the trough B, and F and F' extend downwardly into the trough. F and F' constitute a "plurality," to be sure, but they are not "oppositely-disposed" save in respect to G.

It would appear, therefore, that said element (1) must include all three members, F, F' and G.

Element (2) of the claim calls for "a candy-puller" which might, if the language of the claim could define an element, mean any part of the machine which would pull candy, but the statute requires that a patentee shall file *both* a written description of his invention or discovery *and* a claim defining his invention or discovery (U. S. R. S. 4888). The plain inference is that any claim whose terms do not conform to those of the

description is indistinct or uncertain and therefore invalid, always provided, perhaps, that in the eye of the law, that is certain which may be made certain. But even if that maxim of equity, of doubtful application in the present instance, were held to apply, and element (2) were tentatively appropriated to the screw-shaft H, for example, that would strip element (3) of an element essential to that large generic scope signified in the word "means" employed therein.

Wherefore, the conclusion that the meaning of the claim is hopelessly vague and uncertain, appears to be inevitable.

## V.

### No Infringement.

(a) BECAUSE THERE IS NO IDENTITY BETWEEN THE SUBJECT MATTER OF THE DICKINSON PATENT AND RESPONDENT'S MACHINE.

In support of this proposition, it is believed that nothing need be added to the clear and concise statement made by the Circuit Court of Appeals for the Ninth Circuit, in matter beginning in middle of page 338 to page 341, inclusive, of the Record, which is incorporated with and made a part of this brief.

(b) BECAUSE OF DIFFERENCE IN PRINCIPLE BETWEEN THE TWO MACHINES.

The alleged principle or mode of operation of

the Dickinson machine is described in the patent as follows:

> "The frame T with the parts thereto attached, is given a reciprocating motion through the batch of candy, but any other suitable means may be used."

It is evident that the two pins F and F' are intended to travel back and forth in a trough B, and as they approach the opposite ends thereof, respectively, to shift partially their relative positions in the trough, and to reverse their direction of motion in the trough.

The sufficiency of the drawing and description to disclose such a machine is denied and reasons for such denial are hereinbefore set forth under caption II, to which reference is here made. Dickinson, towards the end of the specification of his patent, evidently strives to stretch the scope of the language employed therein to its utmost limits. Nevertheless, nowhere in that specification is to be found any reference to "a specified relative in-and-out motion of these parts" as expressed in claim 1 of the said patent. On the contrary, there is not only uncertainty as to what motion is referred to in those words of the claim, but also uncertainty respecting the "parts" that are assumed to be affected by that motion.

Dickinson appears to intend a final summing up of all his efforts after expansive general state-

ment of the scope of his invention in the following:

> "Believing myself, as I do, to be the first to invent a machine for pulling candy comprising a hook and two shifting pins, I desire to claim *the same* (italics ours) in the broadest possible legal manner." (See Record, p. 224, lines 30-34.)

The point we urge in respect to the last quotation is that Dickinson apparently could conceive of no broader definition of his invention than that comprehended in the words: "A machine for pulling candy comprising a hook and two shifting pins." If the said "hook and two shifting pins" are assumed to be the "parts" referred to in claim 1, as subject to means for producing a specified relative in-and-out motion, it still remains uncertain what constitutes that in-and-out motion. It appears to be a vague, uncertain form of expression intended to make of the claim that "nose of wax" that may be bent in any direction to meet occasion, and which this court condemns in,

> *White v. Dunbar,* 119 U. S., 47-51; 30 L. Ed. 303.

On the contrary, in Respondent's machine, constructed after the Langer patent (Record, pp. 297-301), the principle of operation is clear, definite, and plainly distinguished from anything that

can be conceived of the Dickinson invention. In said machine, one pulling member—"a floating puller or carrier 12"—moves constantly and unintermittently in mid-air along a continuous circular path about two fixed pins 8 and 9, and carries the batch of candy always in suspension while pulling it. There is here no occasion to use a trough or receptacle which is indispensable in the Dickinson machine. There is here also not only no uncertain in-and-out motion, but also it is specified that a definite direction of motion of the puller 12 must be maintained. It is clear, likewise, that even so much as a reversal of the direction of that motion will defeat the purpose of the operation of the machine.

In order to clarify this point, reference is made to Figure 4 of the Langer patent (Record, p. 298) wherein arrows indicating direction specified of the motion of the puller 12 are shown. Upon said reference it will appear that the puller 12 moves successively through two osculating circles about two fixed pins 8 and 9, that are, respectively, concentric to those circles. The line of motion of the puller 12 is always in one or another of two true circles; and it is only because of the osculation of the two circles in which it moves, that the puller "is carried through its course of travel, corresponding to the figure 8." (Record, p. 301, lines 5-7). The comparison of its path of movement to a figure 8 cannot be misleading in view of the context.

But it is not enough that the puller 12 move in a circular path, as above described. The pins 8 and 9 must be disposed in a horizontal plane, because otherwise they cannot support the candy against gravity in the pulling operation. It is true that in the horizontal disposition of the pins 8 and 9 the batch of candy that is kept suspended between them tends, under attraction of gravity, to sag down in the middle. That very reason indispensably imposes upon the puller 12 the necessity of exerting a constantly recurring lifting action from below upon the suspended strand of candy to keep it in suspension. The operation of the puller 12 just described is clearly illustrated in Figures 4 and 6 of the Langer patent, and is therein explained in the specification of the operation of the invention (Record, p. 300, lines 85-130 and p. 301, lines 1-7).

If the direction of motion of the puller 12 were reversed so that it would strike the batch of candy stretched between the pins 8 and 9 from above instead of from below, the puller would cooperate with gravity to strip the candy from the machine, and the operativeness of the Langer machine would be lost. It therefore appears that the principle of operation of Respondent's machine does not include any mere "in-and-out motion" of his pins 8, 9, and 12, but only a definite motion for a definite purpose.

"Where there is diversity of principle, there is no infringement."

*Field v. De Comeau*, 116 U. S. 187.
*Westinghouse v. Boyden Brake Co.*, 170 U. S. 537.
*The Paper Bag Case*, 210 U. S. 416.

Even if there were no diversity of principle, as there is here, a patent cannot cover a mode of operation. As this Court has said in *Westinghouse v. Boyden Brake Co, supra:*

"But after all, even if the patent for a machine be a pioneer, the alleged infringer must have done something more than reach the same result. He must have reached it by substantially the same or similar means, or the rule that the function of a machine cannot be patented is of no practical value. To say that the patentee of a pioneer invention for a new mechanism is entitled to every mechanical device which produces the same result is to hold, in other language, that he is entitled to patent his function."

To like effect:

*Burr v. Duryee*, 1 Wall., 531.
*Knapp v. Morss*, 150 U. S. 221.

It is repeated here, for emphasis, that Dickinson is not a pioneer, despite Petitioner's protests to the contrary; but his application was i

part rejected on the patent of 1893 to Firchau (Record, pp. 269-270 and 266), as the record shows on page 213. The record also shows (p. 214) that Dickinson accepted said rejection, and in view of it cancelled a claim of his application—a claim, be it observed, of broader scope than claim 1 in controversy.

## V.

### (c) THE ONLY EVIDENCE OFFERED TO ESTABLISH THE ALLEGED INFRINGEMENT IS INCOMPETENT.

Under the above head we refer to the deposition of Petitioner's expert, Livermore (Record, pp. 278-292). Said deposition was taken in the absence of any one representing defendant (Record, p. 292).

The incompetency of the witness is apparent, we submit, from the very nature of his testimony, which is an attempt to establish by speculation only propositions that must be supported by actual fact proof as is declared to be the rule in both the Third and the Fourth Circuits in the two cases already cited *(Supra*, p. 34).

But the testimony of the witness cannot be relied upon for other and weighty reasons.

The witness does not testify from knowledge of any machine purporting to embody the alleged invention of the Dickinson patent. His speculations are based altogether upon his reading of the patent. Although there is in Petitioner's factory one machine alleged to constitute a me-

chanical embodiment of the subject matter of the Dickinson patent (Record, p. 74, Hildreth's testimony), the witness knows nothing about it—has never seen it, so far as his testimony shows. Just here, it is in order again to suggest that the discrepancies and insufficiencies render it impossible to build a machine in accordance with the specification of the Dickinson patent. It is not unreasonable to infer that that is the real reason why so experienced an expert, as Mr. Livermore is, should testify in this case without seeing the machine.

In the Paper Bag case, 210 U. S., 416, this Court has said:

> "To decide the question of infringement, a comparison of the machines is necessary and a determination of their similarity or difference."

The language quoted above is construed to have in contemplation two actual machines. That view is borne out, it is believed, by the opinion of the Court in *Royer v. Coupe*, 29 Fed. Rep. 358, wherein Judge Carpenter instructed the jury as follows:

> "If you find that the machine will not break hides—not do the work it is expected to do—then in that case defendant is entitled to your verdict."

The same or similar doctrine is recognized in

*Kelleher v. Darling,* Fed Cas. 7635, p. 232.
*McComb v. Brodie,* Fed. Cas. 8708.

and other cases, and is believed to be established.

Again it has been held, even though a claim can be read on defendant—appellant's device, infringement is thereby suggested, not proved, and the prior art, as well as the disclosure must still be studied.

*Tostevin-Cottie Mfg. Co. v. Ettinger,* 254 Fed. Rep. 434.

The line of decisions last noted leads to consideration of what is necessary to constitute a patentable invention.

In *Reckendorfer v. Faber,* 2 Otto, 347, this Court said:

> "Looking at this section alone (the patent statute of 1836, in all material respects the same as Rev. Stat. Sec. 4886) it may be safely said no one is entitled to a patent unless (1) he has invented an art, machine, or manufacture. . . . It is not sufficient that it is alleged, or even adjudged, by some officer to possess these requisites. It must in fact possess them; and that it does possess them the claimant must be prepared to establish, in the mode in which all other

claims are established; to wit: before the judicial tribunals of the country."

Since, therefore, the expert witness, Mr. Livermore, is the only witness offered in the present case to support the charge of infringement, and especially in such a case as the present in which it is sought by legal construction only of a claim to establish infringement of a patent by a machine widely differing from the machine shown in the patent, we are emboldened, by the authority of the case last quoted, to submit for the consideration of this Court the following:

The theory of Counsel for Respondent, resting upon the line of decisions immediately preceding, is that reduction to practice is, in all cases, essential to the completion of the inventive act, and without it no one can be an inventor within the meaning of the patent statute of the United States.

*Robinson on Patents*, Vol. I, sec. 125.
*Reed v. Cutter* (Story J.) Fed. Cas. 11645, page 438.
*Westinghouse E. & M. Co. v. Saranac Lake Elec. Light Co.*, 108 Fed. Rep., 221.

We are well acquainted with the doctrine of constructive reduction to practice by the filing of an allowable application for patent, and of the presumptions that attend the grant of a patent, but we maintain that such doctrines apply only

to plain cases, which require no stretch of imagination, such as the present case requires, to enlarge their apparent scope. It would seem that where a claim like the one at bar is urged, that the doctrine laid down in Reckendorfer v. Faber, *supra*, p. 45 should apply, and that the Petitioner herein is bound to establish an extraordinary claim by proof.

The necessity for reduction to practice, *within a scope outside of the ordinary or obvious meaning of the claim*, was urged by counsel before the District Court at the trial of this cause, but Judge Wolverton dismissed the contention (Record, p. 21) in the following:

> "Reduction to practice is but an element in an investigation for determining who is the original and first inventor, where two or more persons who have conceived a supposedly novel idea respecting a device or combination not theretofore known or used are each seeking to establish the right to a patent as the prior and first inventor."

Thus the learned judge restricts the application of the doctrine of the necessity for reduction to practice to cases of interference in the Patent Office, and refuses to allow its broader application to the case at bar.

Besides the incompetency of the witness, Livermore, by reason of his want of acquaintance with the true subject matter of the Dickinson patent,

we contend that his testimony also is incompetent because it is irrelevant and fails to fit the case.

The contention of irrelevancy of the testimony last adverted to, is supported by the fact that the entire theory of the witness Livermore, and all of his conclusions are contingent upon a false assumption. "Thus IF," says the witness (Record, beginning line 4 from bottom p. 282) "the hank or batch of candy extended from one to the other of the pins F and adhered to or was wrapped around the same their effect in passing the pin G would be practically the same as the effect of the hands of the operator relative to the stationary hook in the hand-pulling operation." (Compare Livermore Sketch No. 1 (Record, p. 303), with Livermore Sketch No. 2 (Record, p. 304).

The condition which the witness postulates, namely, adherence of the candy to the pins F ($F^1$) is a condition that does not and cannot, it is submitted, exist in the Dickinson alleged machine. According to the patent the candy rests in the bottom of a trough B, and the pins F and $F^1$ extending downwardly from above into the trough will, if actuated, only stir the candy around in the trough as Respondent's expert witness Ross testifies (Record, p. 119); and as petitioner, Hildreth, corroborates (Record, pp. 65-66).

For the convenience of the Court, we insert here a reproduction of Livermore's Sketch No. 2, taken from Record, page 304.

Fig. 1.

Fig. 2.

Fig. 3.

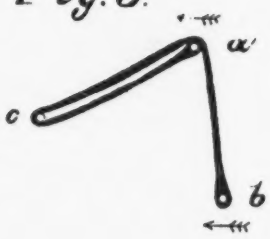
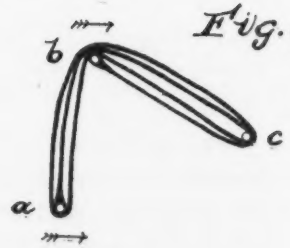



Fig. 4.

Fig. 5.




Referring to said sketch, the attention of the ourt is invited to the fact that there is no evi- ence in the case to connect the sketch, its show- g, or the inferences made by the witness Liver-

more therefrom, with the Dickinson patent or its disclosure.

The so-called "strands" of candy referred to by the witness (Record, pp. 287 and 290) and depicted in said sketch as extending in Fig. 1 between pins a and b and between pins a, b, and c in Figs. 2 to 5, inclusive, are pure figments of the imagination of the witness. No such "strands" are shown to be formed by the machine alleged to be shown in the Dickinson patent. On the contrary, the patent refers only to the movement of the pins F and F' (a and b of the sketch) "through the batch of candy supported by the receptacle B" (Record, p. 223, lines 103-4). The motion so produced is nothing more than a stirring motion. This inference is strengthened by Hildreth's testimony (Record, p. 59) that the Dickinson machine "originally was made with a double jacket in there for keeping the candy warm"; that "stirring candy does not pull candy"; and (Record, p. 60) that "Dickinson did not understand what was necessary when he made that."

The testimony of Hildreth, the petitioner, ought, it is submitted, to put an end to controversy, but to continue, assuming, *arguendo,* that a strand a-b as shown in Figure 1 in above sketch were somehow formed, it must by gravitation lie flat in the bottom of the trough or receptacle B, where a strong tendency will be developed by the force of adhesion to cause it to stick. But pretermit-

ting that untoward circumstance for the argument's sake, and humoring the theory advanced by the witness, when the pins a-b as shown in Fig. 2 are caused to assume the relative positions ascribed to them in Fig. 3, there must ensue a buckling of the "strand" c-a upon itself and a minute attenuation of the "strand" b-a. It were futile to attempt to pursue the argument further. Instead of lapping of strand upon strand, there will be only a pushing of the batch of candy, for the most part, against the side of the trough B. The result would be no better, if so good, as that obtained by the machine of the Firchau patent (Record, p. 269 *et seq.*) in which, let is be observed, the fingers H and $H^1$ not only "are carried in opposite directions" (Record, p. 270, line 77) to "pull or work the candy" (Ib. line 75) but also co-operate with the inner surface of the drum C, comprising the *stationary* surrounding hollow cylinder D, that constitutes, in combination with the fingers H, $H^1$, a third element of the combination. The Firchau specification, carrying all the favoring presumptions of the patent grant, recites:

> "In the practical operation of my improved machine, the candy is introduced into the drum through the door i, formed in the body D, and is hung upon one of the fingers of the head, preferably the inner finger $H^1$. The door is then closed and the machine is set in motion when the heads E, $E^1$ will be rotated

in opposite directions as described and the candy depending from the inner finger will be engaged by the finger H, and will be carried in the opposite direction and stretched and worked. This takes place at each rotation of the heads, the candy being alternately massed and stretched, and thoroughly worked." (See Record, p. 270, lines 98-104, and p. 266, lines 1-8.)

Thus the Circuit Court of Appeals for the Ninth Circuit is more than substantiated in its very conservative conclusion:

> "It is thus seen that Dickinson did not get very far beyond Firchau and that in his device as in Firchau's, the candy is alternately massed and stretched" (Record, p. 335, last two lines, and 336, first two lines).

Proceeding immediately, the Court very pertinently adds:

> "Although claim 1 of the Dickinson patent does not call for means to support the candy against gravity, it is obvious that the device will not operate without a trough for support, such as the specifications describe, and that if the pins were placed in a horizontal position they could not be so operated as to sustain the candy against gravity, for the reason of the intermittent relaxation of the candy from all tension."

Nest follows the quotation from Judge Learned Hand's decision in Hildreth v. Auerbach, 223 Fed. Rep. 545, already noted *(supra,* p. 33).

Thus in few words the Court records its consideration and effectual disposition of Petitioner's contention that in the combination alleged to be defined in claim 1 in suit, the trough B is not contemplated as an element. Said contention is made despite the recognition throughout the patent of its necessity, and despite the fact that Hildreth testifies (Record, p. 78, last answer and question preceding it) in regard to the alleged Dickinson machine, which he testifies he *changed* so as to make it work (See Judge Wolverton's opinion Record, pp. 21-22) that *he still retained the trough.*

## V.

(d) LIMITATION OF CLAIM I OF THE DICKINSON PATENT BY ITS VERY TERMS DIFFERENTIATES ITS SUBJECT MATTER FROM RESPONDENT'S MACHINE.

Without qualifying in any wise our contention that claim 1 is invalid for reasons set forth under caption IV of this argument, we solicit attention of the Court to the limitation of said claim in respect to the term "oppositely-disposed" used to qualify "candy hooks."

It has been already observed *(supra,* p. 36) that the hooks or pins F, F' are oppositely-disposed to the hook or pin G. At this time the attention of the Court is invited to the further fact claim 1

was the sole issue granted to Dickinson as an outcome of the decision of priority awarded to him in Interference No. 21523 (See Record, p. 213), and also to the fact that the limitation "oppositely-disposed candy hooks" is applicable to every one of the machines of the several contestants in that Interference according to the list of them—in evidence—on page 169 of the Record.

Said list includes the following:

1. The Dickinson patent in suit.
2. Hildreth patent, 832,384, Defendant's Exhibit A (Record, pp. 238-242) shows "oppositely-disposed candy hooks" in members designated H, H', and member designated A in said patent.
3. Jenner patent, 804,726, Plaintiff's Exhibit No. 16, (Record, pp. 235-237) shows "oppositely-disposed candy hooks," in members respectively designated by numerals 1, 2, and 3, and by numerals 5 and 6, in said patent.
4. Thibodeau patent, 736,713, issued August 11, 1903, should be 736,313, (Record, pp. 243-247) shows "oppositely-disposed candy hooks" in members respectively designated by numerals 1 and 2, and by numerals 3 and 4, in said patent.
5. Robinson patent, i. e. Robinson and Deiter patent, 881,442, Defendant's Exhibit J (Record, pp. 263, 265, and 271) shows "opposite-

ly-disposed candy hooks" in members respectively designated by numerals 14 and 19, and by numeral 17 in said patent.

6. Henry patent, 731,681, Plaintiff's Exhibit 14, (Record, pp. 227-228) shows "oppositely-disposed candy hooks" in members respectively designated by numerals 7 and by numerals 10—there being two sets of said oppositely-disposed members, one set for each side of the machine, which is in that manner organized into a single machine of a double capacity.

Besides the six patents above enumerated, there are six other patents of record which belong to the same period, all being identified therewith by the same differentiation to wit, "oppositely-disposed candy hooks." Said patents are designated as follows:

Thibodeau, 857,770 (Record, pp. 229-234).
Thibodeau, 772,442 (Record, pp. 248-251).
Thibodeau, 779,141 (Record, pp. 252-255).
Thibodeau, 781,853 (Record, pp. 256-259).
Thibodeau, 859,788 (Record, pp. 261-262).
Igou, 752,979 (Record, pp. 272-277).

The two foregoing lists each include six patents —twelve patents in all. They are all alleged to be the property of Hildreth, the petitioner (See Record, pp. 100, 318, 320). The whole number—twelve in all—belong as already observed to the

type characterized by having "oppositely-disposed candy hooks."

Hildreth's commercial machines—the only types actually manufactured by him for commercial use are of two styles and no more (Hildreth's testimony. Record, pp. 80 and 87). Style A is made under the Thibodeau patent, No. 857,770, dated June 25, 1907, (See Record, pp. 86, 229-234, and 309-327). Style D is stipulated to be substantially the same as Style A (Record, p. 87). Style R is built under the Henry patent, No. 731,681 (See Record, pp. 81, 86, and 327).

By contrast with each and every one of the twelve patents owned by Hildreth, as above listed, Respondent's machine constitutes a new and entirely distinct type. In Respondent's machine there are no oppositely-disposed candy hooks. Respondent's machine establishes a new class—class entirely removed from that defined in claim 1 by the term "oppositely-disposed candy hooks."

About this class differentiation there can be no controversy, because petitioner's expert and principal witness, Livermore, definitely establishes it for a fact when he testifies (Record, pp. 288-9):

> "The machine shown in the Langer patent is what may be called a double machine having the driving mechanism at the middle and two sets of pins, one projecting from each side of the driving mechanism and each adapted to operate to pull a batch of candy

so that two batches may be pulled at the same time. Each set of pulling hooks is, however, entirely independent of the other, and would perform its operation just the same whether the other was present or not."

Each set of pins referred to in the above quotation includes three pins, of which two, 8 and 9, are fixed, and the third, 12, is movable around the other two, alternately (See Record, pp. 297-301—the Langer patent—and p. 289—Livermore Deposition). Of each set of pins, all the pins project only in one direction, and operatively considered, no one of them is oppositely disposed to any other. Each pin of each set is placed butt to butt of the corresponding pin of the other set, but this is a mere incident of the double construction of the machine explained by Livermore in the words of his deposition last quoted.

VI.

In the progress of this cause through the courts below, reference was urged on behalf of the Petitioner here, to his prior litigation in suits in court, and to divers interference proceedings in the Patent Office, and before the Circuit Court of Appeals of the District of Columbia. Those causes the Circuit Court of Appeals declined to consider (Record, p. 338) for the obvious and good reason that they had no possible bearing on the case presented to it.

In respect to suits in other courts aforesaid, there was in every instance nothing in common between the respective issues therein joined and the issue in the present case, one essential difference being that in the present case the main issue relates to the question whether a specific machine, to wit, the Langer machine, infringes the Dickinson Patent.

In respect to the interference proceedings aforesaid the proposition is elemental that the sole question raised in an Interference is one of priority of invention. The question of reduction to practice for instance, and other collateral questions, cannot be adjudicated in an Interference.

Commissioner Mitchell, whose ability both as a commissioner and as a lawyer is well recognized, in 1889 in effect said: The Patent Office has no means of determining whether or not an invention has been reduced to practice, *and assumes for the purpose of declaring an interference* (italics ours), that the inventions involved therein are substantially within the issue, although the subsequent history of the rival inventions may show that one of them is in a form which is afterwards demonstrated to be of great commercial value, while the other is incapable of any practical use whatever.

Green v. Hall, 47 Official Gazette, 1631.

Commissioner Mitchell's decision is believed to make it clear that so far from determining any question of operativeness raised in this case at bar, the interference decision rather sets up a

good and sufficient reason why Petitioner should have been put to his proofs, especially since the real question here relates to what constitutes the true scope of the alleged invention of the Dickinson patent.

The Court's attention is earnestly solicited to the fact, as developed in the record and in the petition for certiorari, that it is the obvious if not the openly declared purpose of the Petitioner to protract the period of the monopoly he has already enjoyed to the uttermost by any legal means in his power. The limiting of the present suit so as to include only claim 1 of the Dickinson patent is one instance toward that end. Petitioner is within his rights, it is freely admitted, in adopting any course the law allows; but also it must be recognized that it is possible for one to abuse a right or privilege. We do not say that there is any disposition upon the part of the Petitioner to abuse any rights whatever; but what we do urge is, that if this Court should recognize the justice of Respondent's cause, as we trust it will, it will consider and frame its decision so as to quiet Respondent's title, and give him peaceful enjoyment of all rights that properly belong to him under the Langer patent, so far as they might be jeopardized by any action it were otherwise in the power of the Petitioner to take.

In a desire to make our meaning unmistakeable, we are moved to add that Petitioner, even if defeated in his present suit, will still own numerous

claims of the Dickinson patent that are not involved in the present action, and is the accredited owner of eleven other patents, all more or less intimately related to the Dickinson patent, as has been hereinbefore set forth.

Petitioner has given notice that it is his purpose, if this Court should decide against him, to bring other suits against Respondent. If he is permitted so to do, the Court's decision in the present case being adverse to him, it will subject Respondent to great hardship and heavy loss.

Now, in view of the fact which we have under the last heading labored to lay clearly before the Court, it is evident we submit, that the whole substantial right of the Petitioner is summed up, generically, in claim 1 of the Dickinson patent. That is to say, if it be held that Respondent does not infringe that claim it must follow he does not infringe any claim that may be predicated upon the *invention* described in the Dickinson patent. Moreover, while we cannot and do not ask adjudication of any question not before the Court, we submit that the full import of the facts proved of record in this case is that the ultimate decision in favor of Dickinson in the interference proceedings, in which all the parties thereto are those whose patents Petitioner has acquired and now owns, establishes it to be the fact that all said patents were, by award made in said Interference, subordinated to Dickinson. If this be accepted to be true, it follows that a decision here in favor of

the Respondent ought in equity to dispose of any question of infringement either of the Dickinson patent or of any of Petitioner's admittedly subordinate patents that can be raised.

The force of this appeal to the consideration of the Court is enhanced, we submit, by Petitioner's clear admission, previously noted, that he has no specific patent showing the specific construction of Respondent's machine (Record, p. 94).

Respectfully submitted,

JOSEPH L. ATKINS,
W. A. ROBBINS,
*For the Respondent.*

Portland, Oregon,
April 15, 1921.